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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,549	01/27/2000	DANIEL HENRY DENSHAM	GJE-35	6468

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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/463,549

Applicant(s)

DENSHAM, DANIEL HENRY

Examiner

Bradley L. Sisson

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,30-34,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,30-34,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 14 June 2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Notice to Comply.

<b>Notice to Comply</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/463,549	DENSHAM, DANIEL HENRY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bradley L. Sisson	1634	

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☐ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☒ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☐ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

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**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY**

## **DETAILED ACTION**

### ***Location of Application***

1. The location of the subject application has changed. The subject application is now located in Workgroup 1630, Art Unit 1634, and has been docketed to Primary Examiner Bradley L. Sisson.

### ***Sequence Rules Compliance***

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

3. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 1634

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3-8, 30-34, 36, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

6. For convenience, claim 1, the sole independent claim pending in the instant application, is reproduced below.

Claim 1 (thrice amended):

1. A method for sequencing a polynucleotide, comprising the steps of:

- (i) reacting a target polynucleotide with a polymerase enzyme immobilised on a solid support, and complementary nucleotides, under conditions sufficient for the polymerase reaction; and
- (ii) detecting the interaction between the polymerase, the target polynucleotide and a specific nucleotide complementary to the target polynucleotide, wherein the nucleotide is incorporated into a nascent polynucleotide being synthesized as a result of the polymerase reaction, to thereby determine the sequence of the target polynucleotide, the detection being carried out by using surface plasmon resonance to measure a change in, or absorption of, radiation that occurs during the interaction.

7. For purpose of examination, the method of claim 1 has been interpreted an encompassing the determination of any length of polynucleotide, including full-length chromosomes. Said method has also been interpreted as encompassing the simultaneous sequencing of an infinite number of polynucleotides that are present in a single mixture.

8. The claimed method has also been interpreted an encompassing both direct and indirect immobilization of any polymerase on any solid support. Such language has been further construed as to encompass the binding of the polymerase to a target polynucleotide, where the target polynucleotide is directly or indirectly bound to the solid support.

9. The claimed method has also been construed as encompassing the determination of the complete nucleotide sequence where no blocking step is performed, and where all possible nucleotides are present in a given mixture, thereby allowing for full length transcripts.

10. The specification has not been found to set forth in "such full, clear, concise, and exact terms" a reproducible method whereby any nucleic acid could be sequenced to completion, wherein said nucleic acid can be of virtually any length, that the nucleic acid be present in a heterogeneous mixtures of other polynucleotides, and/or where all possible nucleotides are present and nascent sequences are allowed to develop unimpeded.

Art Unit: 1634

11. In accordance with claim 7, the method employs a blocking group at both the 3' terminus and the terminal phosphate, with selective removal of the terminal phosphate. Page 7, last paragraph, of the specification states in part that "the blocking groups should be capable of being distinguished on the basis of their spectral absorbancy, i.e., it should be possible to remove selectively one of the blocking groups..." The aspect of the specification teaching as to what might, could, or should be possible does not reasonably suggest that applicant was in possession of this aspect of the invention at the time of filing. It appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

12. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1, 3-8, 30-34, 36, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

13. Claims 1, 3-8, 30-34, 36, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it

Art Unit: 1634

pertains, or with which it is most nearly connected, to make and/or use the invention. As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). . . . We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

14. For purpose of examination, the method of claim 1 has been interpreted an encompassing the determination of any length of polynucleotide, including full-length chromosomes. Said method has also been interpreted as encompassing the simultaneous sequencing of an infinite number of polynucleotides that are present in a single mixture.

15. The claimed method has also been interpreted an encompassing both direct and indirect immobilization of any polymerase on any solid support. Such language has been further



Art Unit: 1634

construed as to encompass the binding of the polymerase to a target polynucleotide, where the target polynucleotide is directly or indirectly bound to the solid support.

16. The claimed method has also been construed as encompassing the determination of the complete nucleotide sequence where no blocking step is performed, and where all possible nucleotides are present in a given mixture, thereby allowing for full length transcripts.

17. Of the examples provided, that found at page 14, bridging to page 15 of the disclosure is most relevant to the claimed method. As set forth therein the results obtained are presented in Figure 2. For convenience, Fig. 2a is reproduced below.

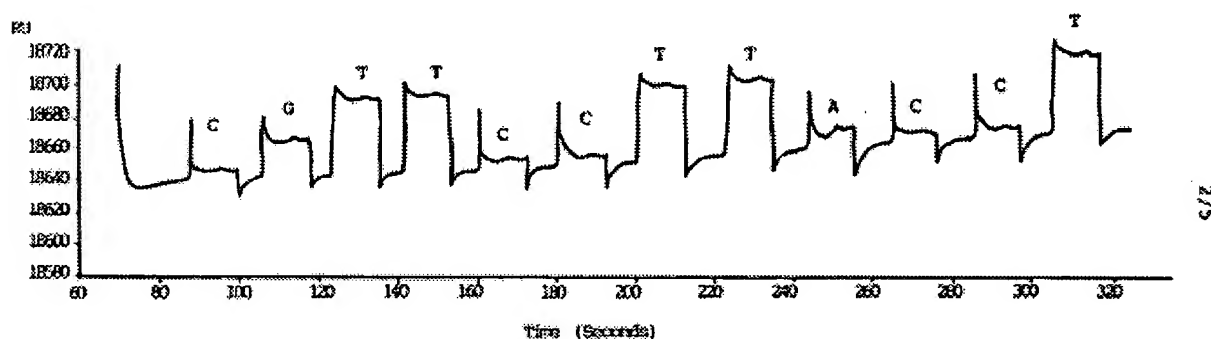


Fig. 2a

18. It is evident from the disclosure, including Fig. 2a, that the but a single template was being sequenced, an then the nucleotide sequence was determined at a rate of about 1 nucleotide per 20 seconds. Significantly, but a single nucleotide was incorporated into the complementary strand at a time, and that further nucleotide addition was proscribed due to the presence of a blocking group in the 3' position.

19. The specification does not set forth a reproducible procedure whereby dual blocking groups are present and are selectively removed.

Art Unit: 1634

20. It is evident that the template is being held in place due to interaction with the immobilized polymerase. The aspect of density of template on any given area of the surface of the solid support, as well as the length and ability to form self-self duplex structures speaks to significant issues of operability and functionality. A review of the specification fails to find any teaching of how dense a target sequence can be applied to a surface, as well as to limitations of the length of same so as to avoid self: self duplex structures which in turn would block effective primer extension reactions.

21. In view of the breadth of scope claimed, the limited guidance provided, the unpredictable nature of the art to which the claimed invention is directed, and in the absence of convincing evidence to the contrary, the claims are not enabled by the disclosure. Therefore, and in the absence of convincing evidence to the contrary, claims 1, 3-8, 30-34, 36, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

### ***Double Patenting***

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1634

23. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

24. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

25. Claims 1, 3-8, 30-34, 36, and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,623,929 B1 (Densham). Although the conflicting claims are not identical, they are not patentably distinct from each other because both claimed methods are predicted upon the synthesis of polynucleotides and are interrogated through the use of surface plasmon resonance.

26. Claims 1, 3-8, 30-34, 36, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 11, 12, 16, 17, 21, and 22 of copending Application No. 10/478,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are drawn to a method of sequencing a polynucleotide.

27. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1634

28. Claims 1, 3-8, 30-34, 36, and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/786,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a method of sequencing a polynucleotide.

29. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1634

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "B. L. Sisson".

Bradley L. Sisson  
Primary Examiner  
Art Unit 1634

BLS  
27 January 2005